



0-19-05

JC03 Rec'd PCT/PTO 17 MAY 2005

PCT 165

**THE UNITED STATES PATENT
AND TRADEMARK OFFICE**

Appl. No. : 10/524,996
Applicant : Hiroyuki ASADA et al
Filed : February 18, 2005
For : STABLE OPHTHALMIC SOLUTION
COMPRISING LATANOPROST AS
ACTIVE INGREDIENT
Art Unite : 1615
Docket No. : 05105/HG
Customer No.: 01933
Confirm. No.: 3212

Express Mail Mailing Label
No.: EV 620 174 934 US
Date of Deposit: MAY 17, 2005

I hereby certify that this paper is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 on date indicated above and is addressed to MAILSTOP AMENDMENT Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.


Dorothy DeFrancesco

In the event that this Paper is late filed and the necessary petition for extension of time is not filed concurrently herewith, please consider this as a Petition for extension of time, and to the extent not tendered by check attached hereto, authorization to charge the extension fee, or any other fee required in connection with this Paper to Account No. 06-1378.

INFORMATION DISCLOSURE STATEMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

MAIL STOP AMENDMENT

S I R :

This application is a United States national phase application of International application PCT/JP2003/010607.

A copy of the International Search Report for PCT/JP2003/010607 was filed on February 18, 2005.

Submitted herewith are the following:

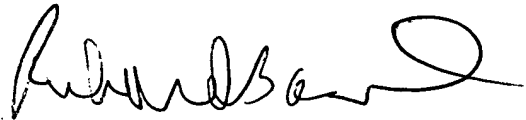
- (1) copies of the foreign publications cited in the International Search Report for PCT/JP2003/010607;
- (2) a copy of EP 1 321 144 which is a related family member of JP 2002-161037 (which was cited in the aforesaid International Search Report);

(3) copies of the following publications which are described on pages 1 and 2 of the present specification:

- (a) JP 2721414 (and its corresponding family member WO 90/02553);
 - (b) Journal of Glaucoma, 10(5), 401-405 (2001)
- (4) a copy of copending related application Serial No. 10/526,822 filed March 4, 2005; and
- (5) Forms PTO/SB/08A and PTO/SB/08B.

It is respectfully requested that initialed copies of the Forms PTO/SB/08A and PTO/SB/08B be returned to the undersigned to indicate that the documents listed therein have been considered and made of record.

Respectfully submitted,




RICHARD S. BARTH
Reg. No. 28,180

Frishauf, Holtz, Goodman
& Chick, P.C.
767 Third Ave., 25th floor
New York, NY 10017-2023
Telephone: (212) 319-4900
Facsimile: (212) 319-5101
E-Mail Address: BARTH@FHGC-LAW.COM

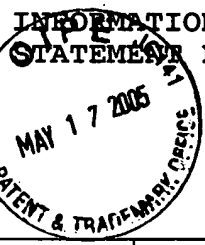
RSB/lpv

Encs: Forms PTO/SB/08A and PTO/SB/08B and copies of documents cited therein

Please type a plus sign (+) inside  box →

PTO/SB/08A (08-00)

U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

| | | | | | |
|---|---|----|---|------------------------|-------------------|
| Substitute for Form 1449A/PTO INFORMATION DISCLOSURE STATEMENT BY APPLICANT  | | | | Application Number | 10/524,996 |
| | | | | Filing Date | February 18, 2005 |
| | | | | First Named Inventor | Hiroyuki ASADA |
| | | | | Group Art Unit | 1615 |
| | | | | Examiner Name | |
| Sheet | 1 | of | 2 | Attorney Docket Number | 05105/HG |

U.S. PATENT DOCUMENTS

| Exam. Inits [*] | Cite No ¹ | Document Number | Kind Code ² | Name of Patentee or Applicant | Publication Date MM-DD-YYYY | Relevant Portion |
|--------------------------|----------------------|-----------------|------------------------|-------------------------------|-----------------------------|------------------|
| | | 6,011,062 | | SCHNEIDER et al. | 06-04-2000 | |

FOREIGN PATENT DOCUMENTS

| Exam Inits [*] | Cite No ¹ | Offc ³ | Document Number ⁴ | Kind Code ⁵ | Name of Patentee or Applicant | Publication Date MM-DD-YYYY | Relevant Portion | T ⁶ |
|-------------------------|----------------------|-------------------|------------------------------|------------------------|-------------------------------|-----------------------------|------------------|----------------|
| | | WO | 00/03736 | A1 | ALCON LAB., INC. | 01-27-2000 | | |
| | | JP | 2002-161037 | A | SANTEN PHARMA. CO. | 06-04-2002 | | ** |
| | | JP | 2001-114700 | A | HISAMITSU PHARMA. | 04-24-2001 | | * |
| | | JP | 2001-81048 | A | WAKAMOTO PHARMA. | 03-27-2001 | | * |
| | | EP | 1 321 144 | A1 | SANTEN PHARM. CO. | 06-25-2003 | | |
| | | WO | 90/02553 | A1 | PHARMACIA | 03-22-1990 | | |
| | | JP | 2721414 | B2 | PHARMACIA | 11-21-1997 | | *** |

| | | | |
|--------------------|--|-----------------|--|
| Examiner Signature | | Date Considered | |
|--------------------|--|-----------------|--|

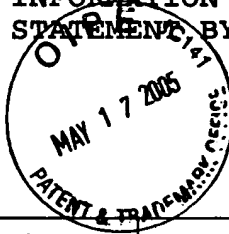
* EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

¹ Unique citation designation number. ² See kinds of U.S. Patent Documents. ³ Enter Office that issued the document, by the two-letter code (WIPO Standard ST.3). ⁴ For Japanese patent documents, the indication of the year of the reign of the Emperor must precede the serial number of the patent document. ⁵ Kind of document by the appropriate symbols as indicated on the document under WIPO Standard ST. 16 if possible. ⁶ Place a check here if English translation is attached.

DATE MAILED: MAY 17, 2005

- * English language Abstract enclosed
- ** EP 1 321 144 is a related family member of JP 2002-161037
- *** WO 90/02553 is a related family member of JP 2721414



| | | | | | |
|--|--------------------------|---|---|------------------------|-------------------|
| Substitute for Form 1449A/PTO INFORMATION DISCLOSURE STATEMENT BY APPLICANT  | | | | Application Number | 10/524,996 |
| | | | | Filing Date | February 18, 2005 |
| | | | | First Named Inventor | Hiroyuki ASADA |
| | | | | Group Art Unit | 1615 |
| | | | | Examiner Name | |
| Sheet | 2 | of | 2 | Attorney Docket Number | 05105/HG |
| OTHER DOCUMENTS - NON-PATENT LITERATURE DOCUMENTS | | | | | |
| Examiner Initials ¹ | Cite No. ¹ | Include name of author (in CAPITAL LETTERS), title of article, title of item, date, page(s), volume-issue number(s), publisher, city and/or country where published | | | T ² |
| | | Parham V. MORGAN et al., "Effect of Temperature and Light on the Stability of Latanoprost and its Clinical Relevance", <u>Journal of Glaucoma</u> , 10(5), 401-405, (2001). U.S. patent application Serial No. 10/526,822 filed March 4, 2005. | | | |
| Examiner Signature | | | | Date Considered | |

* EXAMINER: Initial if document considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

¹ Unique citation designation number. ² Place a check here if English translation is attached.

DATE MAILED: **MAY 17, 2005**